

REMARKS

Claims 1-19 are pending and under consideration. In accordance with the foregoing, the drawings, specification and claims 1, 4, 5, 10, and 14 -19 are amended.

No new matter is presented and, accordingly, approval and entry of the foregoing amended drawings, specification and claims are respectfully requested.

CLAIM AMENDMENTS

Claims 1, 4, 10, and 14 are amended to recite that units are --detachable-- from the electronic apparatus, e.g., mountable to a drive bay. (See page 2, lines 22-25).

Claims 4-5 are amended to correct informalities as suggested by the Examiner. Claims 14-19 are amended to improve form.

No new matter is presented in any of the foregoing and, accordingly, approval and entry of the amended claims are respectfully requested.

ITEM 3: OBJECTION TO CLAIMS 4 AND 5

Claims 4 and 5 are objected to because of informalities.

Claims 4 and 5 are amended herein as suggested by the Examiner. Accordingly, withdrawal of the objection to the claims is respectfully requested.

ITEM 4: OBJECTION TO THE DRAWINGS (Action at page 2)

The Office Action Summary does not have a status block checked indicating any drawing objection. However, in item 4, the Examiner objects to the drawings on page 2 under 37 CFR 1.83(a), the Examiner contending "the table as per claim 8; [and] the judging part as per claims 1, 2, 4, 5, 7-13" must be shown in the drawings.

Traverse of the Objection

Applicant submits these features are shown in the drawings.

"Table" is Shown

The specification describes "the table provided beforehand in the information processing (unit) 203." (See page 20, lines 8-10). The information processing unit 203, that includes the "table," is shown in FIG. 3.

"Judging" Part is Shown

A "judging part" is shown in FIG. 3 as CPU 211. As described in the specification:

[T]he CPU 211 turns on the power switch 204 through the bridge circuit 217 and judges which PC card is inserted in the PC card slot 116 (step S2).

(See page 16, lines 10-12; emphasis added).

Moreover, the CPU 211 judges whether the DVD-ROM drive unit 110 is connected to the multibay 108 or not in step S6.

(See page 17, lines 15-17; emphasis added).

Conclusion

Since the "table" and the "judging part" are shown in the drawings, withdrawal of the objection to the drawings is respectfully requested.

ITEMS 7-12: REJECTION OF CLAIMS 1-2, 6, 10, 14 AND 15 UNDER 35 U.S.C. §102(e) AS ANTICIPATED BY NAKASHIMA (U.S.P. 6,029,211)

The rejections are respectfully traversed.

Anticipation (§102) requires that each and every element or limitation as set forth in a claim be described in a single prior art reference i.e. *In re Robertson*, 49 USPQ 2d 1949 (Fed. Cir. 1999). Nakashima does not adequately support an anticipatory-type rejection, since it does not disclose the elements recited in independent claims 1, 10, 14 (and the claims respectively dependent therefrom).

ITEMS 8, 11, 12: REJECTION OF INDEPENDENT CLAIMS 1, 10 AND 14

The Examiner contends Nakashima "taught":

a judging part judging whether a combination of a plurality of units is to realize a desired function [a judging part ("selection signal discriminator" of figures 1 and 4, "controller" of figure 2, 6, and 7) selects combinations of functions within a PC card are selected to enable a PC card to realize a function . . .];

(Action at pages 3 for claim 1, at pages 5 for claim 10, bracketed text is also Examiner's).

The Examiner also contends that Nakashima:

must have a power supply to supply only the desired functions and power supply control . . . activating must be equated to supplying power. Because only selective functions are powered it is inherent that Nakashima must have a power supply control part to effectively control power only to desired functions. Further, Nakashima discloses controlling power by the judging part to a combination of units based upon an aspect of the combination to [col. 6 line 58 through col. 7 line 10] [sic].

(Action at page 4).

Further, the Examiner contends "Nakashima taught the claimed electronic apparatus therefore he taught the method for controlling the power supply." (Action at page 6).

Traverse

Nakashima does not describe either the claimed selection signal discriminator, or the claimed controller, as a judging part, as the Examiner contends --or any other part. In Nakashima:

Controller 2 is provided with a CIS switch setting element 11, which has a selection signal discriminator 12.

Selection signal discriminator 12 reads in a selection signal applied from selection signal input means 4, and from that selection signal determines the CIS that has been selectively designated.

(See col. 2, lines 12-15).

The Applicant submits that the controller 2 and the selection signal discriminator 12 of Nakashima are not the herein claimed judging parts, judging whether a combination of a plurality of units is to realize a desired function --instead the claimed controller 2 and selection signal discriminator 12 of Nakashima merely read in a selection signal for a CIS that previously "has been" designated.

Further, Nakashima does not describe a judging of a combination of units detachable from an electronic apparatus. A unit, as understood by those skilled in the art, and described in the present application, includes, for example:

a CD-ROM unit, a DVD-ROM drive unit, a hard disk drive unit or a magneto-optical disc drive unit . . . mounted to the drive bay 6.

(See page 2, lines 22-25).

The Examiner admits that "Specifically Nakashima teaches a PC card having a plurality of functions." (Action at page 4). However, the Examiner appears, mistakenly, to equate Nakashima's "functions" as corresponding to the application's "units." Nakashima does not describe functions within a PC card as a plurality of units, as the Examiner contends. For example, Nakashima does not describe any combinations of CD-ROM units or DVD-ROM units within a PC card.

Further, Nakashima does not describe a power supply control part controlling a supply of power from a power source to at least one unit of a combination used to realize a desired function based on a judgment result of a judging part, based on an aspect of a combination of a plurality of units.

The Examiner has not provided any evidence, or supporting rationale, for his contention that Nakashima has a power supply control part. (See MPEP §2112 requiring "EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY"). In the lines in Nakashima cited by the Examiner as disclosing controlling power by the judging part, Nakashima merely describes a "reduction in current drain." (See col. 7, line 4). Applicant submits it is not the understanding of those in those skilled in the art that a "reduction in current drain" describes, as recited in claim 1, a power supply part "controlling a supply of power from a power source."

Nakashima furthermore does not describe, as recited in claim 14 (currently amended), judging of a combination of a plurality of units, and does not describe controlling a supply of power from a power source to one of the units --and the Examiner has not provided any citation to any such disclosure in Nakashima.

Conclusion

Since elements and limitations of the independent claims 1, 10, and 14 (currently amended) are not disclosed in the Nakashima reference, Applicant submits that the rejections should be withdrawn, and the claims allowed.

Item 9: Rejection of Claim 2

The Examiner contends that Nakashima's judging part comprises:

an information judging part judging (selection signal discriminator 12 [sic] whether said desired function is realized based on the identification information obtained from said plurality of units[col. 6 lines 13-20] . . . This identification information part identifies a plurality of units on each card. The judging part (selection signal discriminator [sic]) then selects which functions are to be selected based upon the particular signal.

(Action at pages 4-5).

Even assuming *arguendo* that the selection signal discriminator is a judging part, which it is not, the selection signal discriminator does not do anything, based on identification information obtained from a plurality of units. Instead, in Nakashima:

Selection signal discriminator 12 reads in a selection signal applied from selection signal input means 4, and from that selection signal determines the CIS that has been selectively designated.

(See col. 2, lines 12-15).

As described earlier, Nakashima's cards do not have units therein. The Nakashima selection signal discriminator does not, nor does any other part in Nakashima, identify a plurality of units on each card.

Item 12: Rejection of Claim 15

Claim 15 (currently amended) recites a method of controlling a supply of power where a judging comprises judging whether a desired function is realized, based on identification information obtained from a plurality of units. Nakashima does not describe any judging of whether a desired function is realized, and the Examiner has not provided any citation to such description in Nakashima.

Conclusion

Applicant submits that dependent claims 2, 6, and 15 (currently amended) are allowable, in view of the nondisclosure, by Nakashima, of the recited elements of the respective independent claims. In addition, the dependent claims add additional features that independently distinguish over Nakashima.

ITEMS 13-14: REJECTION OF CLAIM 3 FOR OBVIOUSNESS UNDER 35 U.S.C. §103(a) BY NAKASHIMA IN VIEW OF JONES (U.S.P. 6,145,046) AND LIEBENOW (U.S. P. 6,522,640)

Claim 3 is rejected for obviousness over Nakashima in view of Jones and Liebenow. The Action concedes that "Nakashima did not expressly disclose that the plurality of units are detachable." (Action at page 6). The Examiner contends it would have been obvious to modify Nakashima:

by making both his ATA memory and modem detachable as taught by Jones and Liebenow. An artisan would have made the modification because the memory can now be easily changed for a different desired memory size. The detachable modem would allow reduce the cost of the computer while providing wireless communication as described by Liebenow [col. 1 line 53 through col. 2 line 16].

(Action at page 6).

Traverse: *Prima Facie* Obviousness Not Established

No Motivation Stated Within the Cited Art To Combine In The Manner Proposed By The Examiner

The courts have repeatedly reaffirmed the "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Sang-Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Applicant submits there is no showing of a motivation in Nakashima to modify Nakashima's single card having multiple functions, so as to provide a separate, respective card for each of the multiple functions.

Proposed Modification Would Render Nakashima Unsatisfactory For Its Intended Purpose

As provided in MPEP §2143.01:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

The stated object of Nakashima is:

to provide a PC card that enables a personal computer to utilize all the functions resident in a multi-function type PC card.

(See col. 2, lines 19-20).

The Examiner's proposed modification of multiple cards would make Nakashima unfit for its intended purpose of utilizing a multifunction type PC card.

Examiner Improperly Taking Official Notice

As provided by MPEP§ 2144.03, the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute."

Applicant submits that the Examiner is improperly taking official notice that a detachable modem will "reduce the cost of the computer."

Conclusion

Since *prima facie* obviousness is not established, the rejection of claim 3 is respectfully traversed.

ITEMS 15-26: REJECTION OF CLAIMS 4, 7-9, 11-13, AND 16-19 FOR OBVIOUSNESS UNDER 35 U.S.C. §103(a) OVER NAKASHIMA

Item 16: Rejection of Claim 4

Claim 4 is rejected for obviousness by Nakashima. The Action concedes that Nakashima does not disclose:

stopping the supply of power to the card when the judging part judges that the device unit does not use the PC card . . . Nakashima does not expressly disclose that if no function were used on the particular card power would be stopped to the entire card.

(Action at page 7).

However, the Examiner contends:

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nakashima by implementing the ATA memory and the modem on separate PC cards.

(Action at page 7).

Traverse: *Prima Facie* Obviousness Not Established

Proposed Modification Would Render Nakashima Unsatisfactory For Its Intended Purpose

The stated object of Nakashima is:

to provide a PC card that enables a personal computer to utilize all the functions resident in a multi-function type PC card.

(See col. 2, lines 19-20).

The Examiner's proposed modification of Nakashima to incorporate multiple cards for respective, multiple functions would make Nakashima unfit for its intended purpose of utilizing a

simple, multifunction type PC card. Since *prima facie* obviousness is not established, the rejection of claim 4 (currently amended) is respectfully traversed.

Items 17, 19, 20, 22, 25: Rejection of Claims 7, 9, 11, 13, and 18

The Action concedes that "Nakashima does not expressly disclose that the combination of the plurality of units is predetermined." (Action at page 8).

Further, with respect to claims 9 and 13, the Action concedes that:

Nakashima does not expressly disclose wherein the judging part judges whether or not a combination of said plurality of units is the predetermined combination when the electronic apparatus is turned on.

(Action at page 10).

Traverse: *Prima Facie* Obviousness Not Established

Claim 7 recites an electronic apparatus, and claim 11 recites a power control apparatus:

connectable to a plurality of units including at least one PC card slot and one driver unit, comprising:

a judging part judging whether a combination of at least two of said plurality of units is a predetermined combination . . .

a power source control part stopping a supply of power to at least one unit in the combination

Claim 9, dependent on claim 7, and claim 13, dependent on claim 11, recite that the judging part judges whether or not a combination of the plurality of units is the predetermined combination when the apparatus is turned on.

Claim 18 recites a method of controlling a supply of power including:

stopping a supply of power to at least one of [said] at least two units in a combination when [a] judging part judges that the combination is a predetermined combination.

As provided in MPEP §2143, "to establish a *prima facie* case of obviousness . . . the prior art reference . . . must teach or suggest all the claim limitations."

Applicant submits that Nakashima does not teach or suggest a plurality of units as a PC card slot and a driver unit, let alone a predetermined combination of a PC card slot and a driver unit. Nakashima does not teach or suggest a judging part judging whether a combination of a PC card slot and a driver unit are a predetermined combination when an apparatus is turned on. Further, Nakashima does not teach or suggest stopping a supply of power to a least one PC card slot and one driver unit.

Since *prima facie* obviousness is not established, Applicant requests withdrawal of the rejections of claim 7, 9, 11, 13, and 18.

Items 18, 21, 26: Rejection of Claims 8, 12, and 19

The Action concedes that:

Nakashima does not expressly disclose wherein the judging part comprises a table for storing predetermined combinations of two of said plurality of units, and said judging part judges whether the combination is one of the predetermined combinations based on the table.

(Action at page 9).

Nevertheless, the Examiner contends it would have been obvious:

to further modify Nakashima by using a table to store the predetermined combinations of two of the plurality of units. . . . Because the combination is in a table the system would be able to recognize that the combination would work together without further change to the system (i.e. it is a proper combination).

(Action at page 9)

Traverse: *Prima Facie* Obviousness Not Established

Claim 8 recites an electronic apparatus, and claim 12 a power control apparatus connectable to a plurality of units including at least one PC card slot and one driver unit comprising:

judging part comprises a table storing predetermined combinations of two of said plurality of units, and said judging part judges whether the combination is one of the predetermined combinations based on the table.

Claim 19 recites a method of judging whether or not a combination of at least two units of a plurality of units including at least one PC card slot and one driver unit.

In MPEP §2143, to establish *prima facie* obviousness "the prior art reference . . . must teach or suggest all the claim limitations."

Applicant submits that Nakashima does not teach or suggest a table storing the predetermined combinations of a PC card slot and a driver unit.

Since *prima facie* obviousness is not established, Applicant requests withdrawal of the rejections of claims 8, 12, and 19.

Items 23, 24: Rejection of claims 16 and 17

The Examiner contends that "Nakashima as modified above taught the claimed electronic apparatus, therefore he taught the claimed method to operate the apparatus." (Action at page 10).

Traverse: *Prima Facie* Obviousness Not Established

Claim 16 (currently amended) recites a method for controlling a supply of power in an electronic apparatus where a judging identifies a type of a device unit and a type of a PC card.

Claim 17 (currently amended) recites a method for controlling a supply of power in an electronic apparatus where the controlling a supply of power supplies the power to a PC card when a judging judges that the PC card is not used with a desired device unit, or when said the judging judges that the PC card is used with the desired device unit and the desired device unit is connected to the electronic apparatus.

Nakashima does not does not teach or suggest any judging of a type of a device unit and a type of a PC card or a judging that a PC card is not used with a desired device unit or a judging that a PC card is used with a desired device unit and the desired device unit is connected to an electronic apparatus.

Since *prima facie* obviousness is not established, Applicant submits that the rejection of claims 16 and 17 (both currently amended) should be withdrawn.

Conclusion

Since *prima facie* obviousness has not been established, Applicant submits that the rejections for claims 4 (currently amended), 7-9, 11-13, and 16-19 (all currently amended) should be withdrawn, and the claims allowed.

ITEM 27: ALLOWABLE SUBJECT MATTER

Claim 5 is objected to as being dependent upon a rejected base claim, but as being allowable if suitably rewritten to independent form.

Applicant appreciates the indications of allowable subject matter. However, claim 5 has not been rewritten to independent form, since patentability is submitted to reside in independent claim 1, and in intervening claim 4/1 (currently amended) from which claim 5/4 directly depends.

CONCLUSION

No new matter is presented in any of the foregoing and, accordingly, approval and entry of the replacement title, substitute specification, amended claims, and new claims are respectfully requested.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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ANNOTATED SHEET

FIG. 3

